

DETAILED ACTION

Acknowledgements

1. Claims 1-15 are pending in this Office Action.
2. This Office Action is given Paper No. 20080328 for reference purposes only.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter and lacks a patentable utility.

3. Claim 15 is not directed towards a specific statutory class, as it does not recite any specific elements or steps. Furthermore, because specific elements or steps are not recited, applicant has failed to claim subject matter that provides a patentable utility.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which

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was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. Claims 9-14 contain mathematical formulas that compute the quantitative values for metrics that monitor organizational change and improvement. However, the specification fails to describe or define the formula components in a way to enable one skilled in the art to make and use the invention as defined by the claims. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-15 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope and, therefore, serves the notice function required by 35 U.S.C. 112, second paragraph, by providing clear warning to others as to what constitutes infringement of the patent. See, e.g., *Solomon v. Kimberly-Clark Corp.*, 216 F.3d 1372, 1379, 55 USPQ2d 1279, 1283 (Fed. Cir. 2000). If the language of the claim is such that a person of ordinary skill in the art could not interpret the metes and bounds of the claim so as to understand how to avoid infringement, a rejection of the

claim under 35 U.S.C. 112, second paragraph, would be appropriate. See *Morton Int 'l, Inc. v. Cardinal Chem. Co.*, 5 F.3d 1464, 1470, 28 USPQ2d 1190, 1195 (Fed. Cir. 1993).

6. Claims 3-14 recite a "combination/method" as set forth in either claims 1 or 2. It is unclear as to what applicant claims (i.e. process, apparatus or system). Appropriate correction is required.

7. Dependent claims 3-14 recite the limitation defining the metric consisting of CLARITY, INVOLVEMENT, LEVERAGE, PRIORITY, RELATIVE PRIORITY and INTEGRATION. There is insufficient antecedent basis for "the metric" in the claims 3-14 or in the independent claims 1 or 2 from which claims 3-14 depend upon. Appropriate correction is required.

8. Claim 15 recites "Each and every novel feature and/or combination of novel features herein disclosed", which does not distinctly point out or claim the subject matter which the applicant views as his invention. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 and 6-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Townsend (US 6631473).

9. With respect to **claims 1 and 2**, Townsend teaches the system and method comprising:

- a. means defining the status of complex system/organization components in terms of issues and relationships (column/line 3/5-12); and
- b. second means for quantifying the agreement among various system/organizational components relative to selected systems/organizational tool characteristics (column/line 3/55-62)
- c. whereby benchmarks are established for orienting and/or monitoring system/organization change and improvement (column/line 4/3-7).

10. As to **claim 3**, Townsend teaches wherein said tool characteristics include: the metric "CLARITY" (column/line 6/40-45).

11. Regarding **claim 4**, Townsend teaches wherein said tool characteristics include: the metric "INVOLVEMENT" (column line 6/49-62).

12. With respect to **claim 6**, Townsend teaches wherein said tool characteristics include: the metric "PRIORITY" (column/line 4/43-46, 4/56-5/18).

13. As to **claim 7**, Townsend teaches wherein said tool characteristics include: the metric "RELATIVE PRIORITY" (column/line 4/46-49).

14. Regarding **claim 8**, Townsend teaches wherein said tool characteristics include: the metric "INTEGRATION" (column/line 7/1-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-10 and 12-14 are rejected under 35 U.S.C. 103(a) as being anticipated by Townsend (US 6631473).

15. As to **claims 9, 10 and 12-14**, Townsend teaches wherein said tool characteristics include the metrics of "CLARITY" (column/line 6/40-45), "INVOLVEMENT" (column line 6/49-62), "PRIORITY" (column/line 4/43-46, 4/56-5/18), "RELATIVE PRIORITY" (column/line 4/46-49), and "INTEGRATION" (column/line 7/1-37). In addition, Townsend calculates these metrics using mathematical formulas. Therefore, substituting one mathematical technique for another would have been an obvious modification in light of the teachings of Townsend (*In re Fout*, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967), *In re Wolfe*, 116 USPQ 443, 444 (CCPA 1961), *Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)).

Claims 5 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Townsend (US 6631473) in view of Hambrick et al (US 5671360).

16. With respect to **claims 5 and 11**, Townsend teaches the calculation of various metrics using mathematical algorithms (column/line 4/43-5/18; column 6, lines 40-62; column 7, lines 1-37). Townsend does not explicitly teach a tool characteristic including the metric "LEVERAGE". However, Hambrick teaches wherein said tool characteristics include: the authority metric "LEVERAGE" (column/line 8/22-38). Further, it would have been obvious to modify Townsend by substituting one mathematical technique for another (In re Fout, 213 USPQ 532 (CCPA 1982), *In re Siebentritt*, 152 USPQ 618 (CCPA 1967), In re Wolfe, 116 USPQ 443, 444 (CCPA 1961), *Ex parte Smith*, 83 USPQ2d 1509 (Bd. Pat. App. & Int. 2007)). Therefore, it would have been obvious to one having ordinary skill in the art to modify Townsend with the disclosure in Hambrick because comprises tool that can improve project management by tracking the decision making authority of members of a project.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Cheng (US 6067548), Kourim et al (2003/0120539), McLean et al (2002/0184067).

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRANDI P. PARKER whose telephone number is (571) 272-9796. The examiner can normally be reached on Mon-Thurs. 8-5pm.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin L. Hewitt II can be reached on (571) 272-6709. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/B. P. P./
Examiner, Art Unit 4137

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 4137